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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,893	12/26/2001	Thomas L. McCarthy JR.	118706	9192
25944	7590	10/03/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			BAKER, CHARLOTTE M	
			ART UNIT	PAPER NUMBER
			2626	
DATE MAILED: 10/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/025,893

Applicant(s)

MCCARTHY, THOMAS L.

Examiner

Charlotte M. Baker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claims 14-18 are objected to because of the following informalities: in claim 14, replace "claim 15" with --claim 13--; in claim 15, replace "claim 16" with --claim 14--; in claim 16, replace "claim 17" with --claim 15--; in claim 17, replace "claim 18" with --claim 16--; in claim 18, replace "claim 18" with --claim 17--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svendsen et al. (US 2003/0063770) in view of Hull et al. (6,704,118).

**Regarding claim 1:** Svendsen et al. disclose a document capture device for delivering a scanned document from the user (Fig. 1, multiple peer nodes 16, since a peer node may be a computer (par. 22), it is an inherent feature of a computer to capture a scanned document); a scan server (Fig. 1, peer server 14) for receiving said scanned document from said document capture device (Fig. 1, multiple peer nodes 16, since a peer node may be a computer (par. 22), it is an inherent feature of a computer to capture a scanned document); a metadata acquisition service (Fig. 1, central site 12) receiving a request from said scan server (Fig. 1, peer server 14) to acquire metadata (Fig. 1, metadata 22); a repository manager (Fig. 2, peer data repository 36) for

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receiving a request from said metadata acquisition service (Fig. 1, central site 12) for a capability description; formatted by said metadata acquisition service (Fig. 1, central site 12); by entering metadata values (par. 42 and par. 53); to said metadata acquisition service (Fig. 1, central site 12) for storage and later retrieval by said repository manager (Fig. 2, peer data repository 36).

Svendsen et al. fail to specifically address an email server.

Hull et al. disclose and an e-mail server (Fig. 1, email server 116) for sending an email to the user wherein the user edits said e-mail and sends said e-mail (col. 3, ln. 38-43).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include an email server in order to collect electronic copies of email transmitted over the network as taught by Hull et al. (col. 3, ln. 38-39).

**Regarding claim 2:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 1.

Svendsen et al. further disclose said scan server (Fig. 1, peer server 14) providing temporary document storage (metadata repository 52) while said metadata is acquired from the user (par. 42).

**Regarding claim 3:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 2.

Svendsen et al. further disclose said metadata acquisition service (Fig. 1, central site 12) acquiring said metadata including a URL to a first page of said scanned document (par. 25), user's email address (par. 54), and a target repository's name (preferences of each registered user 18, par. 43).

**Regarding claim 4:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 3.

Svendsen et al. further disclose said capability description includes names of supported repositories (Fig. 2, peer data repository 36; Fig. 3, metadata repository 52) along with metadata

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names supported by each repository (par. 42, par. 49) wherein said metadata acquisition service (Fig. 1, central site 12) formats with said metadata names supported by a specified repository (par. 42, par. 49).

Svendsen et al. fail to specifically address an email as claimed.

Hull et al. disclose an email body (col. 8, ln. 51-59).

**Regarding claim 5:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 4.

Svendsen et al. further disclose said metadata acquisition service (Fig. 1, central site 12) retrieves said first page of said scanned document from said scan server (Fig. 1, peer server 14) (par. 22 and 24) and formats it as an email attachment (par 54).

**Regarding claim 6:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 5.

Svendsen et al. further disclose said metadata acquisition service (Fig. 1, central site 12) and extracts metadata values (par. 42, par. 49, and par. 53).

Svendsen et al. fail to specifically address retrieving an email reply.

Hull et al. disclose retrieves said email reply (col. 8, ln. 51-59).

**Regarding claim 7:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 6.

Svendsen et al. further disclose said metadata acquisition service (Fig. 1, central site 12) returns said metadata values to said scan server (Fig. 1, peer server 14), completing said request for metadata acquisition (par. 42, par. 49, and par. 53).

**Regarding claim 8:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 7.

Svendsen et al. further disclose said scan server (Fig. 1, peer server 14) makes a request of said repository manager (Fig. 2, peer data repository 36) to store said document (par. 40).

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**Regarding claim 9:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 8.

Svendsen et al. further disclose said repository manager (Fig. 2, peer data repository 36) retrieves said captured document from said scan server (Fig. 1, peer server 14) (par. 40).

**Regarding claim 10:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 9.

Svendsen et al. further disclose said repository manager (Fig. 2, peer data repository 36) stores said captured document and its associated metadata into a specified folder in said specified repository (par. 40 and par. 42).

**Regarding claim 11:** The structural elements of the apparatus of claim 1 perform the step of claim 11. Therefore, claim 11 is rejected for the same reasons discussed in the rejection of claim 1.

**Regarding claim 12:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 11.

The structural elements of the apparatus of claim 2 perform the step of claim 12. Therefore, claim 12 is rejected for the same reasons discussed in the rejection of claim 2.

**Regarding claim 13:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 12.

The structural elements of the apparatus of claim 3 perform the step of claim 13. Therefore, claim 13 is rejected for the same reasons discussed in the rejection of claim 3.

**Regarding claim 14:** Since there is a problem with the dependence of this claim, Examiner is interpreting the dependence to be on claim 13. Svendsen et al. in view of Hull et al. satisfy all the elements of claim 13. The structural elements of the apparatus of claim 5 perform the step of claim 14. Therefore, claim 14 is rejected for the same reasons discussed in the rejection of claim 5.

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**Regarding claim 15:** Since there is a problem with the dependence of this claim, Examiner is interpreting the dependence to be on claim 14. Svendsen et al. in view of Hull et al. satisfy all the elements of claim 14. The structural elements of the apparatus of claim 6 perform the step of claim 15. Therefore, claim 15 is rejected for the same reasons discussed in the rejection of claim 6.

**Regarding claim 16:** Since there is a problem with the dependence of this claim, Examiner is interpreting the dependence to be on claim 15. Svendsen et al. in view of Hull et al. satisfy all the elements of claim 15. The structural elements of the apparatus of claim 7 perform the step of claim 16. Therefore, claim 16 is rejected for the same reasons discussed in the rejection of claim 7.

**Regarding claim 17:** Since there is a problem with the dependence of this claim, Examiner is interpreting the dependence to be on claim 16. Svendsen et al. in view of Hull et al. satisfy all the elements of claim 16. The structural elements of the apparatus of claim 8 perform the step of claim 17. Therefore, claim 17 is rejected for the same reasons discussed in the rejection of claim 8.

**Regarding claim 18:** Since there is a problem with the dependence of this claim, Examiner is interpreting the dependence to be on claim 17. Svendsen et al. in view of Hull et al. satisfy all the elements of claim 17. The structural elements of the apparatus of claim 9 perform the step of claim 18. Therefore, claim 18 is rejected for the same reasons discussed in the rejection of claim 9.

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**Regarding claim 19:** Svendsen et al. in view of Hull et al. satisfy all the elements of claim 8.

The structural elements of the apparatus of claim 10 perform the step of claim 19. Therefore, claim 19 is rejected for the same reasons discussed in the rejection of claim 10.

**Regarding claim 20:** Arguments analogous to those stated in the rejection of claim 1 are applicable.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M. Baker whose telephone number is 571-272-7459. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CMB

  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER